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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/028,309

12/28/2001

Steven Holliday

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HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

05/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/028,309

Applicant(s)

HOLLIDAY ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment of 3/5/07 has been entered. Independent claims 1, 7, 10, 43 and 49 have been amended. Claims 1-53 are pending and are rejected as followed.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-53 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The term "Intermediary" as shown in Figs. 2, **element 92**, Fig. 3, step (20) Fig. 5, steps 21, 22, 23, and 24, and specification, pages 4-8, are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It appears that the majority of the specification and the Figures relates to or uses the term "Intermediary" such as "Intermediaries 92". There is not a citation using the term "an agent" or "broker" from the "Summary of the Invention" on page 1 to the end or page 21 or any citation in Figs. 1-10. There is a citation of "sales via agents or brokers" in the "Background of the Invention" but it's not clear what are the relationship of this phrase to the claimed invention. Moreover, the "Background of the invention" does not normally carry a lot of patentable weight since it may be not related to the whole claimed invention.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-53 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 1-53 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed 12/28/01. In that paper, applicant has stated "establishing a relationship between the component of the business entity and an intermediary using the developed plan", and this statement indicates that the invention is different from what is defined in the claim(s) because the intermediary has been deleted and replaced with "agent" or "broker".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) ADLER in view of (2) MORGAN et al or vice versa.

As of 3/5/2007, claim 1 is as followed:

1. (Amended) A process for evaluating a business entity's success in developing new business, comprising the steps of:

(a) developing a strategy and a plan to support at least one of the business entity's high level objectives in a component of the business entity;

(b) establishing a relationship between the component of the business entity and an agent or broker using the developed plan;

(c) establishing a relationship between the component of the business entity and a producer using the developed plan;

(d) establishing a relationship between the component of the business entity and a consumer using the developed plan; and

(e) processing new business resulting from the established relationships.

Similarly, **ADLER** fairly teaches a process for evaluating a business entity objective in developing new business (merger and acquisition), comprising the steps of:

(a) developing a strategy and a plan to support at least one of the business entity's high level objectives in a component of the business entity {see [0002], [0004], [0107]};

(b) establishing a relationship between the modified business entity and an intermediary or "middlemen" using the developed plan {see [0019], [0021]};

(c) establishing a relationship between the modified business entity and a producer using the developed plan {see [0025]};

(d) establishing a relationship between the modified business entity and a consumer using the developed plan {see Fig. 5, 5A, Fig. 9}; and

(e) processing new business resulting from the established relationships {see Fig. 1A, 15, [0002], [0006]}.

Note that ADLER teaches the analysis of the strategic business decisions for different scenarios such as merger and acquisition of business entities. Note that the terms such as “agent or broker” or “intermediary” or “producer” is considered as “non-functional descriptive material” and has no patentable weight. It merely represents a second entity with a function of “producing something” or serving as “agent or broker”. However, the functions are not positively claimed and thus the term has no patentable weight. Moreover, as shown on [0019], ADLER indicates that “intermediary” and “agent” or “broker” are basically the same or interchangeable or read over each other since they act like a “third party” between the “business entity” and the “customer/consumer”, based on how the business is carried out such as on-line (B2B) or off-line (conventional or manually). Also, from the “Background of the invention”, it appears that “intermediary” serves the same function as “agents or broker” or reads over “agent” or “broker”. Therefore, ADLER fairly teaches the claimed invention except for explicitly teaches the carrying out steps (b)-(e) using a component or business unit of the business entity.

In a similar business environment for analyzing business decision (achieve business objectives) for various business scenarios, i.e. trends, forecast, benchmark, site comparison, configuration changes, problem resolution, {see col. 4, lines 1-27, Fig. 1, 50}, **MORGAN et al** fairly teaches the establishing various relations between the most basic functions of an organization/entity (component of a business entity or business unit) and well known business entities, i.e. intermediary, producer, and customer for determining/evaluating the business strategies and obtaining business results (cost) {see Figs. 3, 5, 6 "Business Unit/org" (84) and 7, col. 5, lines 5-67, Table B on col. 9}. It would have been obvious to modify the teachings of ADLER to include the evaluation of a business unit, most basic function of an organization, as taught by **MORGAN et al** to inherently obtain more accurate evaluation.

Alternatively, **MORGAN et al** fairly teaches the claimed invention except for the relationship between the component of the business entity and the entity wherein the component is acquired by the business entity. The teaching of ADLER is cited above. It would have been obvious to modify the teachings of **MORGAN et al** by carrying out scenario of which the component is acquired by the business entity such as merger and acquisition as taught by ADLER above.

As for dep. claim 2 (part of 1 above), which deals with the type of the component of the business entity, a 2nd business acquired by the 1st business, this is taught in ADLER [0002], [0008]}.

As for dep. claims 3-4 (part of 1 above), which deals with well known parameters in establishing relationship with a consumer, i.e. targeting, establishing

contact, and selling a product to the consumer, these are non-essential to the scope of the claimed invention and would have been obvious to a skilled artisan to include these well known steps for conducting business with a consumer, as taught by MORGAN et al on cols. 17-19.

As for dep. claims 5-6 (part of 1 above), which deals with business evaluating parameters, i.e. to access the success (promising strategy) using at least a well known business parameters/metrics, i.e. cost, timeliness, these are fairly taught in ADLER Fig. 1, (15), Fig. 1A (12) "Economic" or MORGAN et al Figs. 3-6.

As for independent system claim 7, which is basically the system to carry out the method of claim 1 above, it's rejected over the system of ADLER/MORGAN et al or vice versa used for the rejection of method claim 1 above.

As for dep. claims 8-9 (part of 7 above), which have the same limitations as in dep. claims 6, 3 (part of 1 above), they are rejected for the same reasons set forth in the rejections of dep. claims 6 and 3 above.

As for independent method² claim 10, which has the limitation of claims 1 and 3, it's rejected for the same reasons set forth in the combination of the rejections of claims 1 and 3 above.

As for dep. claims 11-42, (part of 10 above), which are merely well known parameters for business analyzing and implementing various business relationships, it would have been obvious to use these well known business parameters to carry out the specific steps (a)-(d) as mere using well known business parameters or analysis.

These are fairly taught in MORGAN et al Figs. 1, 7, 8, Tables B, cols. 17-19.

As for independent system² claim 43, which is basically the system to carry out the independent method of claim 10 above, it's rejected over the system of ADLER/MORGAN et al or vice versa used for the rejection of method claim 10 above.

As for dep. claims 44-48 (part of 43 above), which have the same limitations as in dep. claims 2-6 (part of 1 above), they are rejected for the same reasons set forth in the rejections of dep. claims 2-6 above.

As for independent system³ claim 49, which is basically the system to carry out the independent method of claim 10 above, it's rejected over the system of ADLER/MORGAN et al or vice versa used for the rejection of method claim 10 above.

As for dep. claims 50-53 (part of 49 above), which have the same limitations as in dep. claims 2-6 (part of 1 above), they are rejected for the same reasons set forth in the rejections of dep. claims 2-6 above.

No claims are allowed.

Response to Arguments

8. Applicant's arguments filed 3/7/07 have been fully considered but they are not persuasive in view of the examiner's rejections and explanations cited on 2nd paragraph of paragraph no. 7 above or the teachings of ADLER on [0019]-[0020].

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 2003/0097319 by Moldovan teaches method for determining business solution.

2) US 2002/0082882 by Perry et al, discloses a computerized method for evaluating and shaping business proposal.

3) US 2001/0034628, by Eder, discloses a detailed method and system for modeling and analyzing business improvement programs.

4) US 7,107,224 by Weller et al, discloses a value driven integrated build-to-buy decision analysis system and method.

5)US 2003/0249657 by Kol et al, teaches synergism realization for enterprise change.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
May 7, 2007



DEAN T. NGUYEN
PRIMARY EXAMINER